

Remarks

This Response is in reply to the Office Action mailed October 7, 2003.

I. Specification

The Examiner requested the Applicant's cooperation in correcting any errors of which the Applicant becomes aware of in the specification. The Applicant has done so and set forth any found errors in the Amendments above.

II. Claim Objections

Claims 19-23 were objected to based on a missing "and" in Claim 19. Claim 8 was objected to as incorrectly numbered in that Claim 8 should be Claim 9. The Applicant has amended both claims to obviate these objections. The Applicant respectfully submits that these objections be removed.

III. Rejection of Claims 1-27 Under 35 U.S.C. §112, Second Paragraph

Claims 1-27 have been have been rejected as indefinite based on the terms "unique" and "optimized" that the Examiner maintains are "subjective, relative term[s] which render[ ] the claim indefinite." The Applicant has amended all claims to remove these words and therefore respectfully requests that these rejections be removed.

The Examiner further rejected Claim 24 as indefinite since "it is not clear whether the claim is directed to a method claim or apparatus claim." Claim 24 calls for a "computer readable medium having computer instructions stored thereon that, when loaded into a computer system, cause the computer system to perform a method of co-mailing...".

In response, the Applicant submits that Claim 24 is a statutory article of manufacture claim as set forth in M.P.E.P. 2106, IV. B. (a), with the relevant portion of that section reproduced below:

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. See paragraph IV.B.2(a), below.

M.P.E.P. 2106, IV. B. (a) (underline and emphasis added).

Claim 24 calls for a "computer readable medium," a computer memory, and therefore should be analyzed as an article of manufacture claim in accordance with the M.P.E.P. section above. The Applicant respectfully submits that the claim as written is therefore not indefinite under §112 since it is an article of manufacture claim (not a method or apparatus claim).

IV. Rejection of Claims 1-8, 10-12, 14-17, 19-20 and 24-27 Under 35 U.S.C. §102(b)

The Examiner has rejected the above claims under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,287,976 (the Mayer Reference).

A. Claim 1

Claim 1, as amended, calls for, among other things, a co-mailing system comprising:

a merge stream for merging the plurality of first publications and the plurality of second publications into the  
~~unique~~ order to mail the plurality of diverse publications to the plurality of recipients; and  
a sortation device for receiving the plurality of diverse publications merged by the merge stream and sorting each of the

plurality of diverse publications by a mail rate at the optimized mail rate.

The Mayer Reference does not teach or disclose the sortation device of amended claim 1 that receives the individual publications from the merge stream and sorts each of the publications by mail rate. The Mayer Reference has no sortation device after the stacked publications are placed on a conveyer. Rather, the Mayer Reference teaches accumulating the publications onto co-mailing line 28 (FIG. 4), where the publications are fed onto the co-mailing line 28 in a co-mailing stack 40 (the co-mailing stack 40 formed by those publications having common zip code or carrier route (Col. 7, l. 67 – Col. 8, l. 3)). The co-mailing stack 40 is then fed directly into a strapping device 48 (Col. 8, ll. 27-37), without any sorting after placing the publications on the conveyer since the publications are in a stack. An additional embodiment of the Mayer Reference, shown in FIG. 3, shows the publications stacked into pallets 52 and merged on the co-mailing line 28', again as a stack. Thus, both embodiments of FIGs. 4 and 5 of the Mayer Reference depict a co-mailer that merges stacks of publications already in a mail rate order, rather than individual publications that remain to be sorted by mail rate by a sortation device.

In contrast, the present co-mailer, as claimed, calls for a “sortation device for receiving the plurality of diverse publications merged by the merge stream and sorting each of the plurality of diverse publications by a mail rate.” This difference permits the present co-mailer to decrease mail rates paid since the sortation device allows the publications to be sorted singularly (as opposed to being in a stack). This singular sortation, in turn, permits higher volume discounts since more individual publications may be sorted to obtain larger volume discounts. Thus, by having the “sortation device” of claim 1 after the publications are merged, the co-mailer can maximize the mail rate discount from the conveyer when millions of publications must be co-mailed.

The Applicant further submits that the "sortation device" of amended claim 1 is not obvious over the Mayer Reference. As is well-settled, any obviousness rejection requires the following factual inquiries to be set forth by the Examiner: (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and (4) evaluating evidence of secondary considerations. M.P.E.P. 2141. After these factual inquiries are made, it will be clear that amended claim 1 is not obvious over the Mayer Reference for the following reasons.

First, the Mayer Reference teaches away from a sortation device that sorts by mail rate after merging the diverse publications (post-merge). Instead, the Mayer Reference teaches that stacks of publications already in zip code and carrier route order coming off the bindery are placed in stacks onto a merge line already in that mail rate order to avoid further sortation after merger. Column 7, line 67- Column 8, line 3 ("the copies fed to the co-mailing line are accumulated into co-mailing stacks 40 formed by those copies having a common indicia of the assembled mailing information such as zip code and carrier route").

Second, the reference as a whole does not teach a post-merge sortation device. The reference as a whole teaches merger of stacks, not individual publications, and also teaches no post-merger sortation by mail rate. It is impermissible to pick and choose only from the Mayer Reference as much from that reference that will support the obviousness rejection to the exclusion of the remainder of the Mayer Reference that teaches no post-merge sortation device by mail rate.

Thirdly, should the Examiner find a sortation device in any other art area than the mailing industry (e.g. in the materials handling art), such a sortation device is in a non-analogous art that cannot be the basis of an obviousness rejection in the combined mailing art. This is because the requirements of binding and co-mailing diverse publications to obtain minimum mail rates requires stringent rules set forth by the U.S. Postal Service that do not

exist in other material handling art areas. For example, the Post Office rules related to (1) the physical number of the publications needed to obtain volume discounts and (2) the order in which the publications are delivered to the Post Office do not exist in technical areas outside of the mailing industry. A sortation device that is not in the mailing industry therefore does not take these stringent rules into account and is not in an analogous art to permit an obviousness rejection.

For these reasons, Claim 1 is not anticipated by or obvious in view of the Mayer Reference and allowance is respectfully requested.

B. Dependent Claims 2-17

Claims 2 and 7 have been cancelled, without prejudice.

Claims 3-6, 8, 10-12, and 14-17 are dependent on claim 1 and are therefore not anticipated by or rendered obvious in view of the Mayer Reference for the same reasons provided above with regard to amended claim 1.

In addition to the dependence on claim 1, these dependent claims are patentable over the Mayer Reference in their own right. For example, claim 14 calls for a "verified sequence list" that is not taught or suggested by the Mayer Reference. Claim 15 calls for a "verified sequence list" and a "co-mailer merge and sequence module" that are not taught or suggested by the Mayer Reference.

C. Independent Claims 19, 24-28

Independent claims 19 and 24-27 have been amended to add the sortation device or the sorting step, where appropriate, and are therefore not anticipated by or rendered obvious in view of the Mayer Reference for the same reasons as provided above with regard to amended claim 1.

D. Dependent Claims 20-23

Claims 20-23 ultimately depend from amended claim 19 and are therefore not anticipated by or rendered obvious in view of the Mayer Reference for the same reasons provided above with regard to amended claim 19.

V. Rejection of Claims 1-5, 9-12, 14-20, and 24-28 Under 35 U.S.C. §102(e)

The Examiner has rejected the above claims under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,445,975 (the Ramsey Reference).

The Ramsey Reference is purely a binding system and does not teach a co-mailer, or combining a bindery with a co-mailer. Since all the independent claims include a co-mailer, the Ramsey Reference does not anticipate those claims. Accordingly, the Applicant respectfully requests that this rejection be withdrawn.

VI. Rejection of Claims 13 and 21 Under 35 U.S.C. §103(a)

The Examiner has rejected dependent claims 13 and 21 under 35 U.S.C. §103(a) as anticipated by U.S. Patent No. 6,445,975 (the Ramsey Reference), in view of Grausher (U.S. Patent No. 5,025,610).

For the reasons provided above with regard to the Ramsey Reference, claims 13 and 21 are not rendered obvious by the Ramsey Reference, in view of Grausher, since there is no teaching or suggestion of a co-mailer in either reference. Applicant therefore respectfully requests that this rejection be withdrawn.

VII. Allowable Subject Matter of Claims 22 and 23

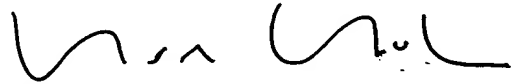
The Applicant acknowledges the Examiner's allowance of dependent claims 22 and 23.

VIII. Conclusion

For the foregoing reasons, the Applicant respectfully asserts that all claims are patentable over the cited prior art and respectfully requests that these claims be allowed.

Should additional fees be due, the Commissioner is authorized to charge any additional fees which may be required or credit any overpayment of fees, to Deposit Account No. 13-0019.

Respectfully submitted,



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